

## ELECTIONS/ RESTRICTION

In response to the Restriction Requirement included with the current Office Action, Applicant hereby elects, **with** traverse, group 1 (claim 36) to prosecute in the above-identified patent application.

The Examiner asserts that claims 28-36 are a distinct species from claim 36 at page 4 of the office action. It is assumed for the purpose of this traversal that the Examiner intends that claims 28-35 are in species II otherwise the species would not be distinct, with claim 36 in both species.

The Examiner also asserts that the claims are different species because they are mutually exclusive. Office Action at page 4, section 4.

It is respectfully asserted that claims 28-35 are not mutually exclusive to claim 36. Nothing about the limitations of one set of the claims is incompatible with the other set of the claims.

The Examiner states that because claim 36 recites details of both species I and species II that a rejection under 35 USC 112, 1<sup>st</sup> paragraph has been raised. In support of this assertion, the Examiner states that “these species are not explicitly disclosed as being in the same embodiment.”

35 USC 112, 1<sup>st</sup> paragraph states:

[t]he specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Firstly, nothing in section 112 requires explicit disclosure that all claim elements are in the same embodiment. The Examiner is kindly requested to point out any such requirement.

Secondly, it is respectfully asserted that one of skill in the art would readily understand the specification and claims 28-36 and would be able to interpret and practice the invention.

To the extent any additional search burden is created, the filing of the Request for Continued Examination on October 7, 2008 is submitted to address this issue.

## REMARKS

Claims 28-35 were withdrawn by the Examiner from consideration as being directed to a non-elected invention according to the Office Action dated January 23, 2009. Claim 36 was rejected.

### *Claim Rejections Under 35 U.S.C. §112*

Claim 36 is rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

As discussed above in the ELECTIONS/RESTRICTIONS section of this Response, this is based upon the examiner's species determination.

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35 U.S.C. §112, 1<sup>st</sup> paragraph states:

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Firstly nothing in section 112 requires explicit disclosure that all claim elements are in the same embodiment. The Examiner is kindly requested to point out any such requirement.

Secondly, it is respectfully asserted that one of skill in the art would readily understand the specification and claims 28-36 and would be able to interpret and practice the invention.

To the extent any additional search burden is created, the filing of the Request for Continued Examination on October 7, 2008 is submitted to address this issue.

Additionally, at page 6 of the office action, the Examiner asserts that "The original disclosure describes these species as separate embodiments. There is not support in the original

disclosure as to how these two species would be integrated into one coherent embodiment; therefore, the combination of these two species into one method is deemed to present an issue of new matter.” Office action at page 6.

Firstly, this is not the case, the specification clearly indicates that these recitations may be used in the same system or method. For example, this is indicated in at least paragraph [200] of the specification:

[w]hile specific reference is made to player losses herein, will be appreciated that the invention may be used to determine a player's winnings or financial gain as a result of game play. As described below, in one or more embodiments, a determination of win may be used for a variety of criteria, including ceasing of further play to ensure the player does not bet won amounts.

Secondly, even if, *ad arguendo*, there was some indication that the subject limitations are present in different embodiments, one of skill in the art, in light of the specification, would clearly be able to understand the teachings of the specification, and the recited claim, and that the subject limitations can be present in one system or method. Both subject limitations are in the specification as filed and claim 36 is therefore fully supported by the specification, as filed, and does not add new matter to the application.

Therefore, it is submitted that claim 36 is fully in compliance with 35 U.S.C. §112.

#### **Claim Rejections Under 35 U.S.C. §103**

Claim 36 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,902,983 to Crevelt et al. ("Crevelt") in view of U.S. Patent Publication No. 2001/0031663 to Johnson ("Johnson") and further in view of U.S. Patent No. 6,012,983 to Walker et al. ("Walker").

It is respectfully asserted that Crevelt, alone or in combination with Johnson and Walker fails to teach the claim 36 limitation of “storing financial information regarding monetary amounts belonging to a player which may be used to play said one or more games, including a threshold win amount limit, above which subsequent play should be limited” (emphasis added).

The Examiner states that “according to Walker, ‘there is provided a method and apparatus for automated play which permits a casino to recognize substantially increased play time, and hence revenue, from a gaming device. At the same time, the invention satisfies a player’s emotional desire to maximize his playing time on selected gaming devices, while accommodating the physical need to at time be away from the machines.’” Office action at page 10.

Walker does not only fail to teach “a threshold win amount limit, above which subsequent play should be limited,” either explicitly or inherently, Walker to the contrary “satisfies a player’s emotional desire to maximize his playing time.” It is not understood how limiting play can be taught or rendered obvious by maximizing play. This is true even if a player’s physical need to be away from the machines (e.g. to go to the bathroom) is accommodated.

Further, Crevelt, alone or in combination with Johnson and Walker fails to teach the claim 36 limitations of “determining an amount won from said financial information; comparing the amount won to the limit on the amount won; and preventing said player from utilizing monetary amounts associated with said account to play said one or more games for at least a period of time if said determined player loss meets certain criteria or if the amount won exceeds the limit.” (emphasis added).

Because this is not taught by Walker, the lack of teachings of the combination of Crevelt and Johnson is not remedied by the addition of Walker. In addition to not teaching this, Walker teaches away from this limitation and from combination with Crevelt and Johnson. The examiner states that the combination would be made “... in order to create an automated play environment which permits a casino to recognize substantially increased play time” Office Action at page 10 (emphasis added). This is directly in contradiction with the claim recitation of “preventing said player from utilizing monetary amounts associated with said account to play said one or more games for at least a period of time.”

Thus, it is submitted that claim 36 is not properly rendered obvious by Crevelt, alone or in combination with Johnson and Walker.

**Information Disclosure Statement**

A Supplemental Information Disclosure Statement is being filed herewith. It is respectfully requested that this Supplemental Information Disclosure Statement be considered and the PTO Form 1449 be initialed and returned with the next Action.

**CONCLUSION**

Accordingly, it is believed that this application is now in condition for allowance and an early indication of its allowance is solicited. Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,  
Weaver Austin Villeneuve & Sampson LLP

/Peter Mikhail/

Peter G. Mikhail  
Reg. No. 46,930

P.O. Box 70250  
Oakland, CA 94612-0250  
510-663-1100